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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,229	10/17/2001	Randy P. Stanley	INTL-0669-US (P12987)	5575

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EXAMINER

NGUYEN BA, PAUL H

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/981,229	STANLEY, RANDY P.	
	Examiner	Art Unit	
	Paul Nguyen-Ba	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Inventor's Declaration filed on 12/3/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the rejection of claims 1-15 over QAS – QuickAddress Software ("QAS"), available at <http://www.qas.com> (circa July, 2001 via The Internet Archive Wayback Machine available at <http://www.archive.com>) under 35 U.S.C. 103(a).

715.07 Facts and Documentary Evidence

> I. < GENERAL REQUIREMENTS

...

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

...

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. **Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b).** *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

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> III. < THREE WAYS TO SHOW PRIOR INVENTION

...

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

- (A) reduction to practice of the invention prior to the effective date of the reference; or
- (B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or
- (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

...

See MPEP § 2138.04 through § 2138.06 for a detailed discussion of the concepts of conception, reasonable diligence, and reduction to practice.

2. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the QAS reference.

Paragraphs 1-5 of the declaration appear to refer to the Intel Invention Disclosure.

However, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. A written description does not constitute an actual

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reduction to practice. Furthermore, only the filing of a US patent application which complies with the disclosure requirement of 35 USC § 112 constitutes a constructive reduction to practice. A written description, no matter how complete, which has not been made the subject of a US patent application does not qualify as reduction to practice.

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the QAS reference to either a constructive reduction to practice or an actual reduction to practice.

Applicant must show evidence of facts establishing diligence. In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention. Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application).

Accordingly, applicant has not established prior invention. The rejection is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over QAS – QuickAddress Software (“QAS”), available at <http://www.qas.com> (circa July, 2001 via The Internet Archive Wayback Machine available at <http://www.archive.com>).

Independent Claim 1

QAS teaches the method of *receiving address data* (see pg. 2 – 4th paragraph → enables address data to be entered accurately and stored consistently in any database) and *comparing the address data to data in an independent database to determine the integrity of the data* (see pg. 4 – 2nd paragraph; pg. 5 – 1st and 2nd paragraphs → compares and verifies address data against the national standard address databases, amending them where incorrect or incomplete and adding the missing elements to ensure accuracy), but does not specifically teach receiving address data *used with personal information management software*.

However, QAS teaches the reception of address data used with various underlying software applications (i.e. customer relationship management (Web, WAP phones), enterprise resource planning, or database applications) (see pg. 4 – 1st paragraph) for the purpose of helping users organize random bits of information.

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It was commonly known to those of ordinary skill in the art that address data could be received from a personal information management software database for the purpose of for the purpose of helping users organize random bits of information.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to receive address data from an underlying software application such as a personal information management software database for the purpose of for the purpose of helping users organize random bits of information.

Claim 2

QAS further teaches the method with respect to claim 1 above, but does not specifically teach including comparing the address data to data in a database on a processor-based system *that also stores said personal information management software.*

However, QAS teaches comparing the address data to data in a database on a processor-based system that also stores various database applications (see pg. 4 – 1st paragraph) for the purpose of helping users organize random bits of information.

It was commonly known to those of ordinary skill in the art that personal information management software can be stored in a processor-based system for the purpose of for the purpose of helping users organize random bits of information.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to store personal information management software in a processor-based system for the purpose of for the purpose of helping users organize random bits of information.

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Claims 3 and 4

QAS further teaches the method of claim 1 including *comparing the address data to data accessible through a network*, such as *the Internet* (see pg. 6 - 1st and 3rd paragraphs → QAS has developed an Internet version of the Address Management software, allowing web developers to easily integrate international address capture tools into any web page or form and validate the addresses against international datasets by linking a group of two or more computers together).

Claim 5

QAS further teaches the method of claim 1 including *automatically determining whether data sought to be entered into personal information management software is consistent with data stored in an independent database* (see pg. 4 – 2nd paragraph; pg. 5 – 1st and 2nd paragraphs → automatically compares and verifies address data against the national standard address databases, amending them where incorrect or incomplete and adding the missing elements to ensure accuracy).

Independent Claim 6

Independent claim 6 incorporates substantially similar subject matter as independent claim 1, and is rejected along the same rationale.

Claims 7 and 8

Claims 7 and 8 incorporates substantially similar subject matter as claims 3 and 4, and are rejected along the same rationale.

Claim 9

Claim 9 incorporates substantially similar subject matter as claim 4, and is rejected along the same rationale.

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Claim 10

Claim 10 incorporates substantially similar subject matter as claim 5, and is rejected along the same rationale.

Independent Claim 11

Independent claim 11 incorporates substantially similar subject matter as independent claim 1, and is rejected along the same rationale.

Claim 12

Claim 12 incorporates substantially similar subject matter as claim 2, and is rejected along the same rationale.

Claims 13 and 14

Claims 13 and 14 incorporates substantially similar subject matter as claims 3 and 4, and are rejected along the same rationale.

Claim 15

Claim 15 incorporates substantially similar subject matter as claim 5, and is rejected along the same rationale.

Response to Arguments

6. Applicant's arguments filed 12/3/2004 have been fully considered but they are not persuasive. Applicant argues the anticipation rejection of claims 1-15. The QAS prior art rejection is not overcome by the submission and entry of Rule 131 Declaration as the declaration is insufficient to overcome the rejection of claims 1-15 over QAS – QuickAddress Software (“QAS”), available at <http://www.qas.com> (circa July, 2001 via The Internet Archive Wayback Machine available at <http://www.archive.com>) under 35 U.S.C. 103(a) because it is not properly executed and fails to establish reduction to practice or diligence prior to the date of the reference.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 10 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER